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May 5, 2017

VIA ECF

The Honorable Paul A. Engelmayer, U.S.D.J.
U.S. District Court, Southern District of New York
40 Foley Square, Room 2201
New York, NY 10007

Re: *Blair v. Alstom Transp., Inc. et al.*, Civil Action No. 1:16-cv-03391-PAE- JLC

Dear Judge Engelmayer:

We represent defendant Kawasaki Rail Car, Inc. (“KRC”) in the above-referenced action. I write to inform Your Honor that the Patent Trial and Appeal Board (“PTAB”) has instituted KRC’s petition for *inter partes* review (“IPR”) of the patent-in-suit, and to respectfully renew Kawasaki’s request for a stay of this action pending the outcome of the IPR in order to avoid duplicative proceedings on overlapping issues.

U.S. Patent No. 6,700,602 (“the ‘602 patent”) is the sole patent asserted in this case. KRC filed a petition for IPR on October 25, 2016, challenging the claims identified in plaintiff’s complaint (claims 1-4 and 6 of the ’602 patent). On March 6, 2017, KRC filed a second petition for IPR challenging the additional claims identified for the first time in plaintiff’s infringement contentions (claims 5, 7-9 and 11-29 of the ’602 patent). On May 4, 2017, the PTAB instituted KRC’s first IPR, concluding that KRC “has established that there is a reasonable likelihood that it would prevail in establishing the unpatentability of claims 1-4 and 6 of the ’602 patent.” A copy of the PTAB decision is attached as Exhibit A. The scheduling order issued by the PTAB is attached as Exhibit B.

On January 10, 2017, Kawasaki¹ filed a motion to stay this litigation pending the outcome of the IPR proceedings. On February 10, 2017, the Court denied the motion; nevertheless, the Court stated that “[i]n the event that the PTAB decides to institute an *Inter Partes Review* of the ’602 Patent, the Court will entertain a renewed application for a stay.” (D.I. 38).

In view of the PTAB institution decision dated May 4, 2017 and the upcoming deadlines in this litigation, KRC respectfully requests that the Court stay this litigation pending completion of the IPR proceedings, including any appeals, for the same reasons outlined in Kawasaki’s original

¹ The motion for a stay (D.I. 29) was filed by the Kawasaki defendant named in the original complaint, Kawasaki Heavy Industries, Ltd. On February 14, 2017, plaintiff filed a corrected complaint that substituted KRC for Kawasaki Heavy Industries, Ltd.

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memorandum of points and authorities. (*See* D.I. 30). A *Markman* hearing is currently scheduled for June 5, 2017 at 10 a.m., and a stay would prevent unnecessary expenditure of time and resources by both the Court and the parties. KRC has conferred with the other parties and plaintiff opposes this motion, but Alstom Transportation, Inc. does not. Alternatively, should the Court wish that this matter be addressed in a motion in accordance with Local Civil Rule 7.1(a), KRC shall make the appropriate submission.

Respectfully submitted,



Sheila Mortazavi

Enclosures